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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,058	12/11/2003	Hikaru Kobayashi	075834.00460	7840
33448	7590	10/13/2010		
ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			EXAMINER MARINI, MATTHEW G	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 10/13/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/733,058

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

MATTHEW G. MARINI

**Art Unit**

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/27/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/27/10 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayama (JP 11-157137). Note: The examiner has relied upon U.S. Patent # 6,532,078 as an English translation of Hayama (JP 11-157137).

As to claims 7 and 10, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, for use in a roll printer, comprising; a printing surface, the top surface of T1, on which one or more images are capable of being printed; a printing layer that is releasably adhered to a release layer, Col. 14 lines 5-13, the release layer for holding said printing layer, top surface of T1, wherein the releasably adhered printing layer, top

surface of T1, and the release layer are rolled together in a spiral shape for form a roll-shaped printing medium, as seen in Fig. 2.

The examiner would like to point out that claim is directed towards a roll-shaped printing medium, where the preamble defines an intended use for that roll-shaped printing medium, i.e. to be used in a roll-printer. (Note that the printer is not part of the claimed combination, but rather a mere intended use.) Therefore, the language directed towards how the roll-shaped printing medium is to be used in the roll-printer reads as intended use, i.e. how the roll-shaped printing medium is to be cut and printed in the roll-printer. The structure of the prior art described above is capable of performing the intended use of the roll-shaped printing medium being used in a printer. Said differently, the roll-shaped printing medium of Hayama, if placed in the intended use printer, will be capable of being cut and printed according an image file (not part of the claimed combination) as recited in claims 7 and 10.

As to claim 8, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, being used in a roll printer wherein said image forming portion, top surface of T1, extends substantially the entire longitudinal length of said print medium, T1, as seen in Figs. 16A-C.

### ***Response to Arguments***

Applicant's arguments filed 8/27/10 have been fully considered but they are not persuasive.

As described above in the rejection of claims 7 and 10, the language directed towards how the roll-shaped printing medium is cut in the "for use" recitation of a printer when a dimension of each image from an original complete image file is to be printed by the intended use printer, reads as an intended use limitation.

Insofar as what is structurally recited defining the roll-shaped medium, the prior art of Hayama is capable of performing the recited intended use of the roll shaped printing medium being used in a printer (which is not part of the claimed combination) and how that medium can be cut according to a dimension to each image from an original complete file.

Note the image and image file does not further structurally define the roll-shaped medium over the prior art because the language does not further define the roll shaped medium but rather merely reads as an intended of the roll shaped medium used in a roll-printer.

Therefore, Hayama is being relied upon for teaching a roll-shaped medium "for use in a printer", and not the printer being disclosed within the reference Hayama. The taught roll-shaped medium is capable of being laterally cut by a printer according to what will be printed and what is printed (i.e. the image file).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW G. MARINI whose telephone number is (571)272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571)-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew G Marini/  
Examiner, Art Unit 2854